

REMARKS

This is intended as a full and complete response to the Office Action dated June 4, 2004, having a shortened statutory period for response set to expire on September 4, 2004. Please reconsider the claims pending in the application for reasons discussed herein.

Claims 1 – 3, 5 – 9, 11-12, and 14 - 27 remain pending in the application and are shown above. Claim 13 has been cancelled, and claim 27 has been added. Claim 25 is indicated to be allowable by the Examiner.

§ 112

Claim 21 stands rejected under 35 USC § 112, first paragraph. The Examiner states that specification is enabling for a "mud pipe" between a plate and a supporting member. However, the Examiner states that the specification does not enable "a fluid conduit for fluid communication between the top drive and the tubular gripping apparatus."

Applicant respectfully traverses this rejection. In the specification, the mud pipe is described as being provided "for carrying mud to the inside of a tubular therebelow." (Pg. 5, Ins. 7-8.) In Figure 4, the mud pipe 32 is between the connecting tubular 12 and the tool 4. Also, the tool 4 is shown inserted into the tubular 40. In Figure 1, the connecting tubular 12 is connected to the top drive 3. It is known in the industry to supply drilling fluid such as drilling mud through the top drive. Thus, drilling mud supplied through the top drive is carried through the connecting tubular 12, the mud pipe 32, and the tool 4, and into the tubular 40. Therefore, the mud pipe acts as a fluid conduit to communicate drilling mud between the top drive and the tubular gripping apparatus. Because the specification would enable a person of ordinary skill in the art to make the invention, withdrawal of the rejection is respectfully requested.

Claim 21 stands rejected under 35 USC § 112, second paragraph, as being indefinite. The Examiner states that it is not clear whether the "fluid conduit" in claim 21 is the same claimed in claims 7 and 8, which was formerly claimed as "mud pipe."

Applicant respectfully traverses this rejection. In the embodiment shown in Figure 2, the "fluid conduit" comprises the "mud pipe." Withdrawal of the rejection is requested.

§ 102(b)

Claims 1-3, 5-8, 12-16, 20-24 and 26, stand rejected under 35 USC § 102(b) as being anticipated by *Boyadjieff*, U.S. Patent No. 4,625,796. The Examiner states that *Boyadjieff* discloses an apparatus for facilitating the connection of tubulars using a top drive 19, the apparatus comprising a plate 44 attachable to the top drive, a supporting member 84 for supporting a tool 42 and a motive member (158, 121, 154) for allowing substantially horizontal and vertical movements of the supporting member.

Boyadjieff discloses a well pipe stabbing and back up apparatus 84 for retaining the upper portion of the drill string against rotation as the added length of pipe connected. As shown in Figure 9, the stabbing apparatus 84 is located near the rig floor and is independent from the top drive. As shown in Figure 1, a pipe handler assembly 21 is suspended from the top drive 19, which is movable axially along a rail 27. Thus, the stabbing apparatus 84 is not used to couple the pipe handler 21 to the top drive. In operation, while the drill string is rotated by the top drive, the stabbing apparatus is in the retracted inactive position of Figure 8. (Col. 6. Ins. 38-50). Therefore, *Boyadjieff* does not teach, show, or suggest a supporting member for supporting a tool and coupling said tool to said top drive, whereby said tool is rotatable by said top drive, as recited in claim 1.

Boyadjieff also does not teach, show, or suggest attaching a tool to the top drive using a supporting member, as recited in claim 14.

Additionally, *Boyadjieff* does not teach, show, or suggest a structural intermediate operatively coupling the tubular gripping apparatus to the top drive, wherein the structural intermediate is adapted to allow the tubular gripping apparatus to move horizontally relative to the top drive and allow the tubular gripping apparatus to be rotated by the top drive, as recited in claim 20.

Therefore, Applicant believes the claims are in condition for allowance and respectfully requests allowance of the same.

§ 103(a)

Claims 9, 11, and 19 stand rejected under 35 USC § 103(a), as being unpatentable over *Boyadjieff*.

Claims 9 and 11 depend from claim 1, and claim 19 depend from claim 14. As discussed above, Applicant believes claims 1 and 14 are in condition for allowance. Therefore, Applicant also believes claims 9, 11, and 19 are in condition for allowance and respectfully requests allowance of the same.

Conclusion

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



William B. Patterson
Registration No. 34,102
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)